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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,363	10/14/2005	Marie-Pascale Latorse	P/3610-63	9080
2352 7590 06/01/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,363

Applicant(s)

LATORSE ET AL.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 will not remain rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et al (US 6503933; 1/7/03) and The Agrichemicals Handbook, A0090 / Aug 91. Moloney teaches a fungicide composition comprising compounds of the instant claims. Moloney teaches compounds of formula I where R₁, R₂ = H; R₃ = 3-Cl, 5-CF₃; R₄ = 2-Me, 5-NO₂ and where R₁, R₂ = H; R₃ = 3-Cl, 5-CF₃; R₄ = 2,6-Cl₂. See compounds 21 and 82 in Table 1. Moloney's compounds are respectively equivalent to elected compounds 2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide (Ia) and N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]-2-methyl-6-nitrobenzamide (Ic). See compounds 21 and 82. The limitations of instant claims 1-11 are met by these two formulas. See compounds 21 and 82 in Table 1. Moloney discloses that fungicidal composition comprising the compounds contain diluent or carrier. See column 3 lines 24-26. Moloney teaches a method of applying a working composition comprising 0.0001 to 1 % of the compound to plants to control fungi although the primary composition contains 5-95 % of the active compound. See column 4 lines 32-38. Moloney teaches that the composition can be applied to plant foliage, plant seed or directly to the soil by a spraying mechanism. See column 4

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lines 39-56. Moloney teaches a method of controlling fungal diseases such as downy mildew in tomato, potato, and vine crops. See column 3 lines 6-23. Moloney teaches that to the compositions comprising the compounds can be added one or more additional actives, e.g. fungicides. Column 3 lines 29-34. Moloney differs from the instant invention in that Moloney does not teach an invention comprising chlorothalonil, and therefore ratio or dose is not taught for instant compounds of formula I and chlorothalonil. However, The Agrichemicals Handbook teaches the compound chlorothalonil is a fungicide. The Agrichemicals Handbook teaches that chlorothalonil is applied to fruit, vegetable (tomato) and cereal crops to control fungi. See reference. It would have been obvious to one having ordinary skill in the art to modify the invention of Moloney to include the chlorothalonil taught by The Agrichemicals Handbook. One would have been motivated to do this since Moloney welcomes the inclusion of other actives such as fungicides. An additional reason for doing this would have been to enhance the effectiveness of Moloney's invention. The combining of the references results in the production of a product / composition / method comprising both active compounds of formula I and chlorothalonil. With respect to the ratio and amounts, it would have been obvious to one having ordinary skill in the art to optimize the amounts / ratios of ingredients. One would have been motivated to do this in order to make the most effective invention for controlling fungi in crops.

Response to Applicants' Argument

Applicants argue that they have discovered a novel and unobvious combination of fungicides that exhibits a synergistic effect that allows a reduction of the chemical

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substances spread into the environment and a reduction of the cost of the fungal treatment. Examiner agrees that Applicants have provided unexpected results for 2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide (1a) and N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]-2-methyl-6-nitrobenzamide (1c) in combination with chlorothalonil. For the reason the rejection of claims 1-17 under 35 USC 103(a) as being obvious over Moloney et al will not be maintained with respect to the combination of (1a) or (1c) with chlorothalonil.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16 and 17 will not remain rejected under 35 USC 112, 1st paragraph.

Lastly, with regards to the prevention (prophylaxis) / curative of fungi growth in crops, the specification lacks the critical steps necessary in presenting some type of predictable response in a population of crops deemed necessary to prevent or cure fungi growth in crops. Reasonable guidance with respect to preventing / curing a said fungi growth relies on quantitative analysis from defined crops which have been successfully pre-screened and are predisposed to particular types of fungi. This type of data might be derived from widespread analysis or crop clusters. The essential element towards the validation of a preventive / curative regimen is the ability to test the composition on crops monitored in advance of fungi infestation and link those results

with subsequent histological confirmation of the presence or absence of fungi. This irrefutable link between antecedent composition and subsequent knowledge of the prevention / curing of the said fungi growth in crop is the essence of a valid preventive / curative agent. Further, a preventive / curative application also must assume that the composition will be safe and tolerable for anyone who consumes or comes in contact with the crop after treatment with the composition. All of this underscores the criticality of providing workable examples, which is not disclosed in the specification.

In view of the teachings above, and the lack of guidance and or exemplification in the specification, it would not be predictable that the invention of preventing / curing fungi growth in crops would function as contemplated. Thus, it would require undue experimentation by one of skill in the art.

Response to Applicants' Argument

Applicant has amended claims 16 and 17 to replace "preventively or curatively" by "combating." Examiner has withdrawn the rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for combating / controlling fungi growth in crops using a composition comprising 2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide (Ia) and chlorothanil (see specification pages 10-14) does

not reasonably provide enablement for curing or preventing fungi growth in crops using said composition. The specification is also enabling for composition comprising 2,6-dichloro-N-[[3-chloro-5-(trifluoromethyl)-2-pyridinyl]methyl]benzamide (Ia) and chlorothanil since unexpected results are provided on pages 10-14 of the specification. However the specification is not enabling for all other compounds of instant formula I being combined with chlorothanil. Other compounds of formula I in the claims are structurally and functionally different from compound Ia.

Response to Applicants' Argument

Applicant argues that USPN 6503993 disclose a large number of 2-pyridylmethylaniline derivatives, including some, if not all, of those of the present invention and disclose their utility as fungicides. Claims 5-9 of that patent are directed to a method of combating phytopathogenic fungi and there are a number of examples demonstrating such utility. It is known in the art that such 2-pyridylmethylaniline derivatives are efficacious for such combat. The Examiner has produced no evidence that would indicate to those skilled in the art the usefulness of these combinations are in any way a fluke.

Examiner agrees that USPN '993 discloses many if not all of the 2-pyridylmethylaniline derivatives instantly claimed and that claims 5-9 of that patent are directed to a method of combating phytopathogenic fungi and that the patent disclose a number of examples demonstrating such utility. However, the specification provides no unexpected results for the composition comprising a compound of formula (I) where R3 and R4 comprises an E being cycloalkyl and cycloalkenyl and very limited unexpected

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are provides where E is heterocyclyl or aryl. The chemical and physical properties of the compound where R4 and R3 comprises an E being aryl, heterocyclyl, cycloalkyl or cycloalkenyl are so different from a compound of formula (I) where R3 and R4 are haloalkyl, alkyl, nitro, and halogen for which the instant specification provides synergistic results. Since the chemical and physical properties of the aryl, heterocyclyl, cycloalkyl and cycloalkenyl groups are so different from the haloalkyl, alkyl, nitro, and halogen substituents physically and chemically, it would be difficult to predict the activity of compounds baring an aryl, a heterocyclyl, cycloalkyl or cycloalkenyl group as opposed to a haloalkyl, an alkyl, a nitro, or halogen group for which results are provided in the specification.

New Rejections

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-19 recite the limitations "the seed," the plant," and "the fruit" in the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moloney et al (US 6503933; 1/7/03) and The Agrichemicals Handbook, A0090 / Aug 91. Moloney teaches a fungicide composition comprising compounds of the instant claims. Moloney teaches compounds of formula I where R₁, R₂ = H; R₃ = 3 E, OE, 5-CF₃; R₄ = 2-Me, 5-NO₂; E = aryl, heterocyclyl, cycloalkyl or cycloalkenyl. Moloney discloses that fungicidal composition comprising the compounds contain diluent or carrier. See column 3 lines 24-26. Moloney teaches a method of applying a composition comprising 0.0001 to 1 % of the compound to plants to control fungi although the primary composition contains 5-95 % of the active compound. See column 4 lines 32-38. Moloney teaches that the composition can be applied to plant foliage, plant seed or directly to the soil by a spraying mechanism. See column 4 lines 39-56. Moloney teaches a method of controlling fungal diseases such as downy mildew in tomato, potato, and vine crops. See column 3 lines 6-23. Moloney teaches that to the compositions comprising the compounds can be added one or more additional actives, e.g. fungicides. Column 3 lines 29-34. Moloney differs from the instant invention in that Moloney does not teach an invention comprising chlorothalonil, and therefore ratio or dose is not taught for instant compounds of formula I and chlorothalonil. However, The Agrichemicals Handbook teaches the compound chlorothalonil is a fungicide. The Agrichemicals Handbook teaches that chlorothalonil is applied to fruit, vegetable (tomato) and cereal crops to control fungi. See reference. It would have been obvious to one having ordinary skill in

the art to modify the invention of Moloney to include the chlorothalonil taught by The Agrichemicals Handbook. One would have been motivated to do this since Moloney welcomes the inclusion of other actives such as fungicides. An additional reason for doing this would have been to enhance the effectiveness of Moloney's invention. The combining of the references results in the production of a product / composition / method comprising both active compounds of formula I and chlorothalonil. With respect to the ratio and amounts, it would have been obvious to one having ordinary skill in the art to optimize the amounts / ratios of ingredients. One would have been motivated to do this in order to make the most effective invention for controlling fungi in crops.

Allowable Subject Matter

Claims 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants provide unexpected results for the invention comprising the compound of formula (I) in claims 19 or 20 plus chlorothalonil. See pages 12-14 of the instant specification.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor
Primary Examiner
AU 1616